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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/634,328
	Filing Date	August 4, 2003
	First Named Inventor	Kenneth Thompson et al.
	Art Unit	3722
	Examiner Name	Fridie Jr., Willmon
	Attorney Docket Number	MCC-44532
Total Number of Pages in This Submission		

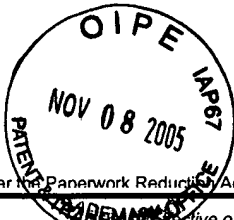
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	KELLY LOWRY & KELLEY, LLP		
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Patent Application effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 250.00

Complete if Known

Application Number	10/634,328
Filing Date	August 4, 2003
First Named Inventor	Kenneth Thompson et al.
Examiner Name	Fridie Jr., Willmon
Art Unit	3722
Attorney Docket No.	MCC-44532

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Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
Indep. Claims	Extra Claims	Fee (\$)
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____				

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

Fees Paid (\$)

\$250

SUBMITTED BY

Signature		Registration No. (Attorney/Agent) 30,762	Telephone 818-347-7900
Name (Print/Type)	Scott W. Kelley		Date November 3, 2005

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BY Scott W. Kelley, Reg. No. 30,762

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

KENNETH THOMPSON, ET AL.

Serial No. 10/634,328

Filed: August 4, 2003

FOR: MULTI-PURPOSE CARD

Group Art Unit: 3722

Examiner: Fridie Jr., Willmon

OUR DOCKET NO. MCC-44532

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
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Sirs:

Applicant hereby submits his Appeal Brief, further to Applicant's Notice of Appeal
From the Examiner to the Board of Patent Appeals and Interferences, dated
September 6, 2005.

11/09/2005 DTESSEM1 00000007 10634328

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I. Real Party In Interest

The real party in interest of this application is James Thompson.

II. Related Appeals and Interferences

Applicant is not aware of any prior and pending appeals, judicial proceedings or interferences which may be related to, direct affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1-26 have been canceled.

Claims 27-32, 34-39 and 41-48 are rejected, and presented on appeal.

Claims 33, 40 and 49 are objected to.

IV. Status of Amendments

No amendments have been presented since the June 3, 2005 Final Office Action. All amendments made previous to the Final Office Action have been entered by the Examiner.

V. Summary of Claimed Subject Matter

The present invention, as recited in independent claims 27, 34 and 41, is directed to a multi-purpose card comprising a base layer defining a wallet-size card and first and second redemption or charging means in the form of first and second integrated circuit chips (page 17, line 24 of the Specification). Each integrated circuit chip contains information relating to a different entity to allow selective charging or redeeming for that entity (page 17, line 24 through page 19, line 32 of the Specification).

Independent claim 17 recites that the first and second integrated circuit chips are mis-aligned to allow selective charging or redeeming for that entity (page 17, line 24; page 18, lines 25-26; Figs. 17 and 21 of the Specification). Independent claim 34 recites that the first and second integrated circuit chips are disposed on opposite surfaces of the base layer to allow for selective charging or redeeming for that entity (page 19, lines 9-11; Fig. 22 of the Specification). Independent claim 41 recites that the first and second integrated circuit chips are aligned on the same surface of the base layer to allow selective charging or redeeming for that entity (page 17, lines 24-26; page 18, lines 12-14; page 19, lines 21-23; Figs. 19, 20, and 23 of the Specification).

Independent claims 27, 34 and 41 recite that the multi-purpose card may be used for different transactions or purposes by selectively passing the first or second integrated circuit chip through a reader, thus redeeming or charging to the selected entity (pages 17-19 of the Specification). On pages 17-19 of the Specification, the multi-purpose card of the present invention is described as particularly useful as a financial transaction card, such as a combined debit and credit card, wherein one of the

integrated circuit chips 58 would contain the information of the debit card, while the other would have credit card information.

On page 18 of the Specification, it is explained that the card could in fact be two different types of credit cards, for example, one-half of the card being Visa[®], while the other half is Mastercard[®], and if the consumer wanted to use his or her Visa[®] card, the user would insert the applicable integrated circuit chip 58 into the appropriate reader. If, on the other hand, the user had to or wanted to use his or her Mastercard[®], he or she would insert the appropriate end of the card into the reader so that the integrated circuit chip 58 representing the Mastercard[®] would be read. Page 18 of the Specification also describes the multi-purpose card as being issued by a single financial institution to bear debit card information and one or two different types of credit cards, so that the multi-purpose card could replace potentially up to three different cards within the user's wallet. Pages 18 and 19 of the Specification also disclose that the multi-purpose card could be used in a retail establishment, as a credit card, etc., each integrated circuit chip representing a different transaction means or redemption means. Page 19 of the Specification also describes integrated circuit chips as representing two different types of financial transaction cards, or having two distinct promotional offers. The Specification, on pages 17-19, describes how the card would be inserted into a reader such that only one of the integrated circuit chips would be read to redeem or charge to the selected entity represented by the read integrated circuit chip. Placing the integrated circuit chips on opposite sides of the cards, opposite ends of the cards,

misaligned, etc., enables the chips on the card to be selectively read to redeem or charge to the selected entity.

Dependent claims 30, 36 and 45 recite a laminate layer, including a hologram, overlying and attached to the base layer (page 20, lines 6-8 and Fig. 23 of the Specification), for additional identification or security purposes.

Dependent claims 31, 37 and 46 recite a picture associated with the card (page 18, lines 12-14 of the Specification) to serve as identification for the cardholder.

Dependent claims 32, 39 and 48 recite a bar code imprinted onto the base layer of the multi-purpose card (page 18, lines 27-29 of the Specification) containing additional information which can be scanned by a reader.

Dependent claims 38 and 47 recite a defined area of the card having information printed thereon and covered with a scratch-off foil treatment (page 19, lines 11-13 of the Specification) to provide the owner of the card with pertinent information such as a PIN number, signature line, or other security or promotional information.

VI. Grounds of Rejection to be Reviewed on Appeal

A. Whether claims 27, 28, 30-32, 41, 42, 44-46 and 48 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Hebbecker (U.S. Patent No. 6,693, 544);

B. Whether claims 29, 34-37 and 43 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over Hebbecker;

C. Whether claims 38 and 47 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over Hebbecker in view of Carides et al. (U.S. Patent No. 6, 106,932).

VII. Argument

A. 35 U.S.C. §102 rejections

The present application is a divisional application of United States Patent Application Serial No. 09/865,652, filed on May 25, 2001 (now U.S. Patent No. 6,623,039). At the time of filing on August 4, 2003, Applicant submitted a Preliminary Amendment canceling claims 1-26, and adding new claims 27-49.

As indicated above, claims 27, 28, 30-32, 41, 42, 44-46 and 48 stand rejected under 35 U.S.C. §102(e) as being anticipated by Hebbecker.

Hebbecker is directed to an electronic identification tag or card which may be equipped with a rupture joint. The electronic identification dog tag has two sections which have a mirror-inverted design, and, in which, the same data is stored in the same manner. The tag or card is provided with punch holes for a necklace. Moreover, visually readable data, such as a personal identification number, blood type, a nation and name, is introduced into both sections. (See, Abstract).

As described in the Background section of Hebbecker, identification tags for people such as soldiers, militia, border patrol, national guard and the like are available and typically are made of sheet metal having two symmetrical halves which are separable by a predefined rupture groove. The tag is worn around on the neck and includes the individual's nationality, personal identification number, blood type and the like which are engraved into each of the two halves. In the event of death, one half is broken off and used to identify the person in question, and the other half remains on the body. Hebbecker indicates that data stored in such conventional identification tags no

longer meets the need of a modern high-tech army. Hebbecker describes that the soldier is considered to be a part of a weapons system as evidenced by his ability, apart from special training such as parachute training and specific competencies. Additional information is useful such as driver's license, knowledge, medical dispositions, vaccinations and allergies, and the like are increasingly required for rapid troop deployment.

Hebbecker describes, in columns 3 and 4 of the Detailed Description that his identification card or tag has a main directory which includes global hard data, including personal identification number, nation, name and blood type. Other information such as training of the person, qualifications of the person, etc. are also in the memory. In the drawings of the Hebbecker patent, FIGS. 2-B, 2-D and 2-E illustrate such an electronic dog tag having two halves and a rupturable joint 7. In particular, FIGS. 2-B and 2-D illustrate an electronic dog tag having integrated or embedded memory or microprocessor chips 4 and 4'. As discussed in column 4, lines 5-30, these identification tags include the integrated or embedded memory or microprocessor chips 4 or 4' which contain the same stored data and exhibit the same structure. In FIG. 2-E, the tag has only a single memory or processor chip 4, and on the other side of the rupture joint is engraved or embossed a portion or all of the data stored in the memory or microprocessor chip and introduced so as to be visually readable (col. 4, Ins. 32-38).

For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927

F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991). For a prior art reference to anticipate in terms of 35 USC § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Moreover, in determining anticipating, functional language, preambles, and language in “whereby”, “thereby”, and “adapted to” clauses cannot be disregarded. *Ipac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 14 USPQ2d 1871 (Fed. Cir. 1990).

The present invention is directed to a multi-purpose card which includes a first and second redemption or charging means in the form of first and second integrated circuit chips. These chips are positioned on the card such that they can be selectively charged or redeemed. For example, the multi-purpose card can, as described in the Specification, be both a debit and a credit card issued from the same or different financial companies or banks. Thus, instead of having to carry a separate debit and credit cards, a single card can accomplish the same purpose. Similarly, a MasterCard® and VISA® could be contained in the same card, each integrated circuit chip representing either the VISA® or MasterCard® redemption means. The chips are placed on opposite sides of the card, or are spaced apart from one another that they can be separately inserted through a reader so as to selectively only charge or redeem against only one of the integrated circuit chips, as described in the Specification.

On the face of the disclosures, the Hebbeck electronic identification “dog” tag is completely nonanalogous to the multi-purpose card of the present invention which is directed to utilizing two different integrated circuit chips containing information

relating to different entities for selective charging or redeeming for that entity. Applicant respectfully submits that one of ordinary skill in the art of the invention would view significant differences between the claimed invention directed to a charge or redemption card and the Hebbecker reference which discloses an electronic dog tag for use by military personnel for identification purposes.

Furthermore, Hebbecker further fails to identically show every element of the claimed invention. Independent claim 27 recites "first and second redemption or charging means in the form of first and second integrated circuit chips, each integrated circuit chip containing information relating to a different entity" . . . "whereby the multi-purpose card may be used for different transactions or purposes by selectively passing the first and second integrated circuit chip through a reader, thus redeeming or charging to the selected entity." Hebbecker does not disclose, teach or even suggest such limitations. In fact, Hebbecker teaches exactly the opposite in that the information contained in the chips 4' contain the same stored data and exhibit the same structure (column 4, lines 10-12; and column 4, lines 26-27). In the Abstract of Hebbecker, it is disclosed that the electronic identification tag or card may be equipped with a rupture joint that has a vertical, diagonal, undulated, zig zag, or other type of design or pattern, so as to have two sections which may have a mirror-inverted design, and, in which the same data may be stored in the same manner. The purpose of forming a rupture joint in the identification tag, with each half of the tag containing an identical memory chip, is that the information pertains to the same soldier. In the event of death of the soldier, one-half of the identification tag is torn away, and the other half remains with the

soldier, as is well known in the use of such dog tags. Thus, Hebbecke does not teach that each integrated circuit chip contains information relating to a different entity, as recited in independent claim 27.

Independent claim 41 includes the same recitations mentioned about with respect to independent claim 27, and thus for the same reasons Applicant respectfully asserts that it is not anticipated by the Hebbecke reference.

If independent claims 27 and 41 are not anticipated by the Hebbecke reference, those claims depending therefrom cannot be anticipated by this reference either. In particular, dependent claims 30 and 45 recite a laminate layer including a hologram, overlying and attached to the base layer. Hebbecke fails to teach or suggest such recitation.

As Hebbecke fails to disclose, teach or even suggest a multi-purpose card having first and second redemption or charging means in the form of first and second integrated circuit chips containing information relating to different entities; as well as failing to teach a multi-purpose card used for different transactions or purposes by selectively passing the first or second integrated circuit chip through a reader, thus redeeming or charging to the selected entity, Applicant respectfully asserts that Hebbecke fails to anticipate claims 27, 28, 30-32, 41, 42, 44-46 and 48 individually.

B. 35 U.S.C. §103 rejections

In the Final Office Action, the Examiner states "Hebbecke discloses the claimed invention except for the claimed location as set forth in the claims. It would have been obvious to the one of ordinary skill in the art at the time the invention was made to locate the chip elements in the claimed location, since it has been held that the

rearranging of parts of an invention involves only routine skill in the art”, citing *In Re Japikse*, 86 USPQ 70. Applicant respectfully disagrees with this assertion. In the present invention, the placement of the chips, for example, on opposite sides of the base layer as recited in independent claim 34, enable each chip to be passed through a reader independent of the other chip, so as to selectively redeem or charge the selected entity. When on the same side of the base layer, the integrated circuit chips must be spaced apart or misaligned in some fashion so that only one integrated circuit chip is read by a reader, and not both. Thus, this invention is not merely a rearranging of parts which is routine to one skilled in the art, but as one skilled in the art would readily appreciate the placement of the integrated circuit chips is critical to the selective charging or redeeming to the selected one of the entities represented on the card. Applicant respectfully asserts that the Examiner has not met his burden in rejecting this aspect of the invention, as recited in claims 29, 34, and 43.

Claims 38 and 47 stand rejected as being unpatentable over Hebbecke in view of Carides et al. Claims 38 and 47 recite a defined area of the card having information printed thereon and covered with a scratch-off foil treatment. In the Office Action, the Examiner properly states that Hebbecke does not disclose a scratch-off foil treatment. However, the Examiner states “Carides et al. teaches that it is well known in the art to use a scratch-off foil treatment to obscure indicia. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Hebbecke with a scratch-off foil treatment to obscure indicia in the manner as taught

by Carides et al. in order to add another degree of security to the document.” Applicant respectfully disagrees with this assertion.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991)).

Applicant respectfully asserts that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Hebbecke reference as suggested by the Examiner or to combine these reference teachings. As described above, Hebbecke is directed to an electronic identification “dog” tag for military personnel. Carides et al. is directed to a method and system for creating game cards incorporating a removable scratch-off coating to hide printed symbols. The card is constructed so that the scratch-off coating is selectively retained by the card, in the form of symbols, when the scratch-off coating is removed.

Applicant respectfully asserts that, the teachings of Hebbecke and Carides et al. are only analogous to one another given the teachings of the present

application, otherwise, the references are completely non-analogous. Of course, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. *Life Technologies, Inc. V. Clonetech Laboratories, Inc.*, 56 USPQ2d 1186 (Fed. Cir. 2000).

Thus, the Examiner has failed to establish the first basic criteria of a *prima facie* case of obviousness: that there must be some suggestion or motivation in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 citing *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant respectfully asserts that the second basic criteria of a *prima facie* case of obviousness has also not been met, that is that there must be a reasonable expectation of success. Applicant respectfully asserts that to incorporate a scratch-off foil coating or treatment to a military dog tag would serve no purpose and given the harsh environment in which the dog tags are placed, could not be successfully incorporated into such dog tags.

Given the foregoing, Applicant can only surmise that the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in the prior art, but instead based on hindsight reasoning in an attempt to reconstruct Applicant's claimed invention. Of course, such hindsight reasoning is strictly forbidden.

Even if the Hebbecker and Carides et al. references are improperly combined, the combination does not teach or suggest all of the claim limitations as Carides et al. fails to disclose the use of first and second integrated circuit chips, each containing information relating to a different entity for selectively charging or redeeming that entity when selectively passed through a reader.

Moreover, neither Hebbecker nor Carides et al. discuss whatsoever the problems solved by the present invention. The present invention provides a multi-purpose card which offers redemption or charging of at least two different entities in a selective manner in a single card. As discussed above, this enables the card to represent both a debit card and credit card, two different credit cards, or include any other two different transactional charging means or promotional redemption means in a single card. In the rare case where the prior art does not appreciate the existence of the problem solved by the invention, the Applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. *In re Nomiya et al.*, 184 USPQ 607, 612-613 (CCPA 1975).

From the foregoing, Applicant respectfully asserts that the currently pending claims are not rendered obvious by either Hebbecker or by the improper combination of Hebbecker and Carides et al.

VIII. Claims Appendix

27. A multi-purpose card, comprising:

a base layer defining a wallet-sized card;

first and second redemption or charging means in the form of first and second integrated circuit chips, each integrated circuit chip containing information relating to a different entity, wherein the first and second integrated circuit chips are mis-aligned to allow selective charging or redeeming for that entity;

whereby the multi-purpose card may be used for different transactions or purposes by selectively passing the first or second integrated circuit chip through a reader thus redeeming or charging to the selected entity.

28. The multi-purpose card of claim 27, wherein the base layer is comprised of plastic or paper.

29. The multi-purpose card of claim 27, wherein the first and second integrated circuit chips are on opposite surfaces of the base layer.

30. The multi-purpose card of claim 27, including a laminate layer including a hologram, overlying and attached to the base layer.

31. The multi-purpose card of claim 27, including a picture associated with the card.

32. The multi-purpose card of claim 27, including a bar code imprinted onto the base layer.

33. The multi-purpose card of claim 27, including a plurality of peel-off coupons detachably connected to the base layer.

34. A multi-purpose card, comprising:

a base layer;

first and second redemption or charging means in the form of first and second integrated circuit chips, each integrated circuit chip containing information relating to a different entity, wherein the first and second integrated circuit chips are disposed on opposite surfaces of the base layer to allow selective charging or redeeming for that entity;

whereby the multi-purpose card may be used for different transactions or purposes by selectively passing the first or second integrated circuit chip through a reader thus redeeming or charging to the selected entity.

35. The multi-purpose card of claim 34, wherein the base layer is comprised of plastic or paper.

36. The multi-purpose card of claim 34, including a laminate layer including a hologram, overlying and attached to the base layer.

37. The multi-purpose card of claim 34, including a picture associated with the card.

38. The multi-purpose card of claim 34, including a defined area of the card having information printed thereon and covered with a scratch-off foil treatment.

39. The multi-purpose card of claim 34, including a bar code imprinted onto the base layer.

40. The multi-purpose card of claim 34, including a plurality of peel-off coupons detachably connected to the base layer.

41. A multi-purpose card, comprising:

a base layer;

first and second redemption or charging means in the form of first and second integrated circuit chips, each integrated circuit chip containing information relating to a different entity, wherein the first and second integrated circuit chips are aligned on the same surface of the base layer to allow selective charging or redeeming for that entity;

whereby the multi-purpose card may be used for different transactions or purposes by selectively passing the first or second integrated circuit chip through a reader thus redeeming or charging to the selected entity.

42. The multi-purpose card of claim 41, wherein the first and second integrated circuit chips are positioned at opposite ends of the base layer.

43. The multi-purpose card of claim 41 wherein the first and second integrated circuit chips are positioned at the same end of the base layer.

44. The multi-purpose card of claim 41, wherein the base layer is comprised of plastic or paper.

45. The multi-purpose card of claim 41, including a laminate layer including a hologram, overlying and attached to the base layer.

46. The multi-purpose card of claim 41, including a picture associated with the card.

47. The multi-purpose card of claim 41, including a defined area of the card having information printed thereon and covered with a scratch-off foil treatment.

48. The multi-purpose card of claim 41, including a bar code imprinted onto the base layer.

49. The multi-purpose card of claim 41, including a plurality of peel-off coupons detachably connected to the base layer.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None

Respectfully submitted,

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